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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,786	02/12/2002	Norishige Morimoto	JP920000444US1	7209
7590 11/02/2007 IBM CORPORATION INTELLECTUAL PROPERTY LAW DEPT. P.O. BOX 218 YORKTOWN, NY 10598			EXAMINER DURAN, ARTHUR D	
			ART UNIT 3622	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/074,786

Applicant(s)

MORIMOTO ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 24 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 24 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37,CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 3-5, 24, 31 have been examined.

#### ***Election/Restrictions***

Applicant's confirmation of the election with traverse of Claims 3-5, 24, 31 in the reply filed on 7/5/07 is acknowledged.

#### ***Response to Amendment***

2. The Amendment filed on 10/22/07 is insufficient to overcome the prior rejection.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/07 has been entered.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 3-5, 24, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace (5,848,396).

Claims 3, 24, 31: Gerace discloses a content registration/management system comprising:

content registration request reception means, for receiving a request for content registration from a content provider that provides content (Figures 5a-5d; col 3, lines 4-20);

identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider (col 17, lines 52-col 18, line 10; col 6, line 57-col 7, line 23); and

a content ledger database, for storing information related to said identifier provided said content provider (col 33, lines 35-col 34, line 27).

As noted in the citations above, Gerace discloses that ad packages are identified, ad series are identified. Gerace also discloses that individual ads are placed in a table (Fig. 5d). Gerace also discloses that individual ads are tracked, performance data for each ad is tracked and reported, and the analysis of the performance of individual ads (col 18, lines 10-26; col 18, lines 50-col 19, line 5; col 5, lines 25-40; claims 9 and 13). Therefore, individual ads are also given identifiers. Identifiers would be necessary for each ad in order to store, track, report, compare, analyze the ads and the ad performance.

Also, Examiner notes that Gerace discloses that advertisements are a form of content or aggregate information (col 2, lines 60-67).

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Claim 4: Gerace discloses the content registration/management system according to claim 3, further comprising:

identifier reception means, for receiving from a user terminal an identifier provided for said user terminal (col 6, line 57-col 7, line 24); and

content reproduction information collection means, for collecting, based on the reception of said identifier, information related to the reproduction of content (col 6, line 57-col 7, line 24; col 33, lines 35-col 34, line 27).

Claim 5: Gerace discloses the content registration/management system according to claim 4, further comprising:

an advertisement ledger database for registering a list of contents that can be used as advertisement media (Figures 2, 3a); and

notification means for searching said advertisement ledger database based on said received identifier, and for transmitting an advertisement distribution request to an advertiser (Figures 2, 3a; col 20, lines 9-30; col 16, lines 45-55; col 33, lines 35-col 34, line 27).

### ***Response to Arguments***

4. Applicant's arguments with respect to the claims have been considered but are not found persuasive. Please read thru to the end of this Response to Arguments section.

On page 13, the Applicant states, "That is, based on the request that is received from the sponsor, the identifier is added to said content, the content intended by the sponsor to be provided to a user terminal with the added identifier (as per the claim as a whole). Not only is the

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identifier in the content, but also the sponsor is provided with the identifier, and knows that its content includes same identifier.”

However, Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, the claims do not state that “the identifier is in the content”. Rather, the claims state that an identifier is set and that an identifier is added to the content. Where or how the identifier is added to the content is not specified.

On page 12 of the Applicant's Remarks dated 10/22/2007, Applicant states, “None of the cited Gerace text discloses, teaches or suggests applicants' identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider.”

However, Gerace discloses what information is provided in content registration (Figures 5a-5d) and that the Sponsor logs in and then registers content with the system (col 17, lines 51-67). Also, Gerace discloses the general network structure thru which Sponsors login and register new content with the system (Figure 3a).

And, Examiner notes that it is not stated whether the content identifier is unique to each piece of content or is unique to the Sponsor. For example, an identifier can be used to identify

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the Sponsor and then the identifier placed with each piece of content. Or, a unique identifier can be made for each piece of content. The claims merely state that there is id related to the content.

And, Gerace discloses that new ads are placed (col 18, lines 35-50; col 19, lines 25-37; col 19, lines 47-55) and that Sponsors register new ads/content (col 17, lines 53-67). Note that a new content/ad necessitates an identifier in order to track/record/monitor the new ad. And, Gerace discloses unique identification of the Sponsor which is associated with the ads/content the Sponsor places (Figures 5a-5d, "Ad Package" and "Sponsor ID", "Ad Series" and "Package ID", Advertisement and "Series ID"). Hence, in Figures 5a-5d and the reporting of Gerace (col 33, line 34-col 34, line 27) every advertisement is uniquely identified and every advertisement is also identified as to what Sponsor the ad was placed by. Note that Gerace can bill the Sponsor by how many times each individual ad was viewed or clicked or an order is placed thru (col 12, lines 7-22). Hence, Gerace tracks and identifies each individual ad and also the ads related with its Sponsor placement. Also, note that in the table for Figure 5d that each record is a different ad and that it is standard database practice that each record in a table is uniquely identified.

Also, Gerace discloses "identification of item selected by user (via click of mouse with cursor positioned on item)" (col 6, line 67-col 7, line 2).

Gerace discloses that new ads are placed (col 18, lines 35-50; col 19, lines 25-37; col 19, lines 47-55) and that Sponsors register new ads/content (col 17, lines 53-67). Note that a new content/ad necessitates an identifier in order to track/record/monitor the new ad. And, as noted in the rejection above, Gerace discloses that ad packages (Figure 5b, "Sponsor ID") are identified (Figure 5c, "Pacakge ID") and ad series are identified. Gerace also discloses that

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individual ads are placed in a table (Fig. 5d). Gerace also discloses that individual ads are tracked, performance data for each ad is tracked and reported, and the analysis of the performance of individual ads (col 18, lines 10-26; col 18, lines 50-col 19, line 5; col 5, lines 25-40; claims 9 and 13). And, Gerace discloses that individual ads are recorded for number of times viewed, number of times selected, number of times purchased from (col 2, lines 35-42). Therefore, individual ads are also given identifiers. Identifiers would be necessary for each ad in order to store, track, report, compare, analyze the ads and the ad performance.

Also, Examiner notes that Gerace discloses that advertisements are a form of content or agate information (col 2, lines 60-67). Hence, in Gerace, the features that apply to content/agate information also apply to advertisements and vice versa.

Hence, Gerace discloses that advertisements are a form of content. And, Gerace discloses that Sponsors can add and register new advertisements/content. And, Gerace discloses that every piece of content is tracked for when it is presented and how the content is interacted with by the user. And, Gerace discloses that ads are placed on specific schedules. And, Gerace discloses that ads are recorded for number of times viewed, number of times selected, number of times purchased from (col 2, lines 35-42). Hence, Gerace in detail discloses unique registration for content and unique identifiers and identifying of content thru the range of content registration, content presentation to the user, content response by the user, and content billing.

Hence, Gerace discloses the features of the Applicant's claims.



*Conclusion*

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) McElfresh (2003/0149937) discloses tracking individual advertisements which are given identifiers (Abstract; fig 3a, 3b);

b) Merriman (5,948,061) discloses tracking individual advertisements which are given identifiers (Fig 3b).

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,


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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Arthur Duran  
Primary Examiner  
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10/29/2007